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09/678,040	10/03/2000	Jeffrey Marsden	50538.2USPT	5664

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EXAMINER
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HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/678,040

Applicant(s)

MARSDEN ET AL.

Examiner

Lalita M Hamilton

Art Unit

3624

MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to because the drawings are too close to the top of the page. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 21, 25, and 27. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 31a and 32a. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "18" has been used to designate both "transaction data" and "financial statistics" in the specification; reference character "12" has been used to designate both "broker demographics" and "broker demographics file" in the specification; reference character "14" has been used to designate both "broker

performance" and "broker performance file" in the specification; and reference character "10" has been used to designate both "system" and "computer system" in the specification. A proposed amendment to the specification is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "40" has been used to designate both "peer ranking table" in the specification and "peer group table" in the drawings and reference character "26" has been used to designate both "transaction master data", "transaction master file", and "transaction master" in the specification and "transaction master" in the drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The abstract of the disclosure is objected to because in line 5, the sentence "The data compilation interface with a Broker Master to correlate a Broker to statistical database as requested by the user" is unclear. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: CAV price file and peer group CAV price file are not described in the specification, but are shown in the drawings and claimed in claims 7-9.

Appropriate correction is required.

Claims 4 and 6 are objected to because of the following informalities: It is unclear to the Examiner what the Applicant is attempting to claim; the claim reads as an incomplete sentence. Appropriate correction is required.

Claims 7-9 and 11 are objected to because of the following informalities: In claims 7-9, CAV price file and peer group CAV price file are not described in the specification. Claim 11 is objected, because of the phrase "as mentioned according to claim 9". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 recites the limitation "CAV profile file" in claim 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 is rejected, because it is incomplete.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added).

Claims 1-11 are rejected under 35 U.S.C. § 101 because; the claimed invention is directed to a non-statutory subject matter. Specifically the system and method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claims may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a system and method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following preamble is suggested: "A computer implemented framework comprising--", "A computer implemented method for ---", or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto (6,681,211) in view of Tertitski (6,493,681).

Gatto discloses a security analyst estimates performance viewing system comprising a compilation of Broker demographics (col.9, lines 1-16—broker information); a compilation of Broker performance data (col.8, lines 55-67); a compilation of Client Portfolio information (col.8, lines 48-55—stocks module: user selects stocks that they may have an interest in investing in); a compilation of periodic Transaction data including volume of Transactions and associated Broker information (col.8, lines 55-67); at least one interface to a Broker Master to correlate a Broker to statistical database as requested by the user (col.8, lines 1-28); wherein the Broker Master correlates financial statistics from Transaction data to Broker demographics and performance data so as to provide an evaluation system (col.8, lines 29-40—analytical tool); wherein a set of criteria assigned to Brokers correlates and ranks the number of Transactions/period and experience each resultant ranking is allocated by a peer group (col.13, lines 22-35 and col.31, lines 15-30); wherein said Brokers are allocated a peer group based upon experience (col.13, lines 22-35 and col.16, lines 10-22—user has the option of grouping based on the chosen characteristics that they are looking for); wherein each of said peer groups experience based and correlates financial statistics from Transaction data to a peer group so as to rank Broker performance within said

peer group (col.5, lines 50-62 and col.13, lines 22-35--user has the option of grouping based on the chosen characteristics that they are looking for); and wherein a peer group price file correlates elements of Transaction data wherein each peer group generating a series of Transaction based financial averages or results associated with each peer group (col.5, lines 50-62 and col.13, lines 22-35—average performance within each group). Gatto is silent with regard to information pertaining to the commissions charged. Tertitski teaches a method and system for visual analysis of investment strategies wherein the user may take into consideration the broker commission charged per transaction (col.3, line 65 to col.4, line 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include information pertaining to commissions charged, as taught by Tertitski into the system disclosed by Gatto, to allow the user to have data pertaining to commissions charged by the broker in attempting to obtain a CAV price file and peer group price file involving broker transactions and commissions charged in order to allow the user to obtain rankings according to this information thus aiding them in their investment decisions.

Claims 5, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto and Tertitski as applied to claims 2 and 6 above, and in further view of Giansante (6,275,814).

Gatto discloses and Tertitski teaches the invention substantially as claimed; however, neither reference discloses nor teaches a client attractiveness value (CAV) being assigned to each client on the basis of total assets invested in all accounts or the CAV and peer group price file generating a means to compare individual brokers to peer

groups. Giansante teaches an investment portfolio system and method comprising what the Examiner is interpreting as being a CAV (col.5, lines 1-30—ranking based on total assets in each investment account or portfolio). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include CAV into data that may be accessed by the user thus allowing the user to have another piece of information to aide them in their investment decision when researching brokers.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto in view of Tertitski and Giansante.

Gatto discloses a security analyst estimates performance viewing system and method comprising the steps of compiling data regarding the identity and experience of each of said Brokers (col.9, lines 1-16 and col.16, lines 10-22); compiling data on target performance and actual performance of each Broker col.8, lines 55-67); compiling information on Clients served by ones respective said Brokers (col.8, lines 48-55 and col.9, lines 1-16); associating said Clients and said Brokers (col.9, lines 1-16); collecting periodic Transaction data including the volume of Transactions and Broker responsible (col.8, lines 29-40); from said Transaction data computing statistical data on the performance of each Broker based on the volume of Transactions (col.5, lines 50-62 and col.13, lines 22-35); utilizing said Broker information to rank said Brokers by experience and allocate to each a peer group (col.13, lines 22-35 and col.31, lines 15-30); and correlating financial statistics from said Transaction data to a peer group to rank a Broker within a peer group (col.5, lines 50-62 and col.13, lines 21-35—user has the option of grouping based on chosen characteristics they are looking for). Gatto is

silent with regard to commissions charged by the brokers and does not disclose utilizing said client information to a ranking of each client to portfolio within a set of designations. Tertitski teaches a method and system for visual analysis of investment strategies wherein the user may take into consideration the broker commission charged per transaction (col.3, line 65 to col.4, line 8). Giansante teaches an investment portfolio system and method comprising what the Examiner interpreting as a ranking of each client to portfolio within a set of designations (col.5, lines 1-30—ranking based on total assets in each investment account or portfolio). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include information pertaining to commissions charged into the data that may be obtained by the user in order to allow the user to obtain rankings according to this information to aide them in their investment decisions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a ranking of each client to portfolio within a set of designations into data that may be accessed by the user allowing the user to have another piece of information to aide them in their investment decision when researching brokers.

***Provisional Application Listed on PTO-892 form***

... If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application,

applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lalita M. Hamilton